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REMARKS

This reply is in response to the Examiner's Answer dated May 18, 2006. A Request for Oral Hearing is attached hereto.

A. Norman Does Not Teach, Show Or Suggest The Claimed Invention

Regarding Norman (US 4,431,524), the Examiner's insistence that "base compound would remain in the oil after this water removal step" in unfathomable. The Examiner is kindly reminded that the water wash step is only one of four mandatory treatment steps prior to glycol addition.

Norman discloses adding an aqueous solution of a basic salt to precipitate metal compounds to form solids and to neutralize acid which can precipitate and/or remain in the aqueous phase. Afterwards, Norman discloses the following processing steps:

2. The bulk water and solids are removed where any unreacted (i.e. excess) base compound is removed.
3. Fine particulates and remaining suspended water are then removed from the oil.
4. The recovered oil is then vacuum dried to remove dissolved water and light hydrocarbons.
5. Finally, the glycol is added to the dehydrated/recovered oil to remove metallic contaminants remaining in the oil.

See, Norman at Abstract and at col. 5,ll. 16 through col. 7, ll. 61.

As outlined above, Norman discloses at least three other treatment steps after the water wash, each step aimed at removing water and water-soluble compounds, including the basic salt, prior to the glycol addition. If any metallic contaminants are left over after Step 4, then there is no base compound present. Otherwise, the basic compound would combine with the metals and precipitate out as a solid, leaving no metal behind. The mere presence of metallic species indicates the absence of the base compound. Accordingly, there is no way anyone of ordinary skill in the art reading Norman would reasonably believe that base compound is present at the time of glycol addition (Step 5).

Therefore, Norman does not teach, show or suggest a used oil mixture comprising used oil, phase transfer catalyst, and base compound, as recited in every claim. Withdrawal of the rejection and allowance of the claims is respectfully requested.

B. A Combination of Norman and Chavet Does Not Teach, Show Or Suggest The Claimed Invention

Regarding the combination of Norman and Chavet (WO 97/00928 or the US equivalent, U.S. Patent No. 6,072,065), the Examiner has not established a *prima facie* case of obviousness. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Lee, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002). In other words, the Examiner must "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." See In re Kahn 04-1616 (Fed. Cir. March 22, 2006). If no explanation is provided, then it is inferred that the Examiner used hindsight. See Id.

Here, the Examiner has merely stated that it would have been obvious "to have modified the process of Norman by distilling to remove contaminants at any appropriate set of conditions as suggest by Chavet because distilling will remove contaminants from a mixture similar to the mixture present in the Norman process and therefore distilling would be expected to be an effective separation method in the process of Norman." That assertion is nothing more than an "obvious to try" standard which the Court of Appeals for the Federal Circuit has held not to be a proper test for determining obviousness under 35 U.S.C. § 103. See In re O'Farrell, 7 U.S.P.Q. 2d 1673 (Fed. Cir. 1988). Obviousness is tested by what combined teachings of prior art references would have suggested to those of ordinary skill in art, not by whether a particular combination of elements from such references might have been "obvious to try." In re Fine, USPQ2d 1596 (Fed. Cir. 1988). Simply because a claimed device or process uses a known

scientific principle does not, of itself, make that device or process obvious. In re Brouwer, 77 F.3d 422, 37 USPQ2d 1663 (CAFC 1996).

In other words, the Examiner has the burden to explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine their teachings to render the claimed invention obvious. According to the record, there is no motivation or expectation gleaned from the references themselves that the treated oil in Norman can be distilled to remove contaminants as taught in Chavet. The treated oil of Norman that is to be distilled according to the Examiner, is not chemically or physically similar to that of the distilled oil in the Chavet. The differences of the oils are discussed at length in the Applicant's Appeal Brief. Therefore, distilling would not be expected to be an effective separation method in the process of Norman absent some teaching, showing, or suggestion from within the references themselves. There is no such teaching or suggestion within the references themselves. Again, simply because a claimed device or process uses a known scientific principle does not, of itself, make that device or process obvious. In re Brouwer. Withdrawal of the rejection and allowance of the claims is respectfully requested.

C. Chavet Does Not Teach, Show Or Suggest The Claimed Invention

The Examiner made no remark or reference to the Applicant's argument concerning the rejection of claims 25-28, 31, 32, 34-36, 41 and 42 under 35 U.S.C. § 103(a) in view of Chavet (WO 97/00928 or the US equivalent, U.S. Patent No. 6,072,065). No further comment by the Applicant is needed. Chavet very clearly states that the water wash step removes all of the base compound. See, Chavet '065 at col. 4, lines 43-47. Therefore, Chavet does not teach, show, or suggest a used oil mixture comprising used oil, phase transfer catalyst, and base compound, as recited in every claim. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Conclusion

The references of record, alone or in combination, do not teach, show, or suggest the claimed invention. "That an inventor has probed the strengths and weaknesses of the prior art and discovered an improvement that escaped those who came before is indicative of unobviousness, not obviousness. Fromson v. Anitec Printing Plates, Inc., 132 F.3d 1437, 45 USPQ 2d 1269, 1276 (Fed. Cir. 1997), cert. denied, 119 S. Ct. 56 (1998). Allowance of the claims is respectfully requested.

Respectfully submitted,

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Date

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